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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,741	08/08/2001	Mark D. Seaman	10010165-1	2927

7590 09/13/2006  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/924,741	<b>Applicant(s)</b> SEAMAN ET AL.	
	<b>Examiner</b> Sam Rimell	<b>Art Unit</b> 2164	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.


### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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Preliminary Notes:

(1) This office action includes new grounds of rejection not necessitated by amendment and is accordingly made non-final.

(2) References to the phrase "Interim Guidelines" are referring to the Interim Guidelines for Examination of Patent Applications Subject Matter Eligibility, published in Official Gazette, November 22, 2005.

(3) References to the phrase "State Street" are referring to *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is non-statutory.

Claim 1: Claim 1 is a method of synchronizing data that produces a result of deleting certain captured data sets. Such a result is not a tangible result, since it is merely a manipulation of data within a computer system. Since the method provides no mechanism in which to generate output which is tangible to a user, the end result is not tangible. The requirement for a tangible result is set forth in *State Street*.

Claim 2-7: Depend on claim 1.

Claim 8: Claim 8 is addressed to a computer readable medium for synchronizing captured image data. On page 7 of applicant's specification, the medium is defined as including "propagation medium" (i.e. signal media) and "paper". In accordance with the *Interim*

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*Guidelines*, computer instructions carried by signal media or written on paper are considered to constitute non-functional descriptive material and are thus non-statutory. The *Interim Guidelines* state:

*“The computer readable medium must be physical structure which provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other types of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a transmitter or a receiver) and a piece of paper with the functional descriptive material written on it are all examples of media which are not believed to enable the functionality to be realized with the computer.”* (emphasis added).

Claims 9-12: Depend on claim 8.

Claim 13: Claim 13 is addressed to a system for synchronizing captured image data with stored image data is a storage medium. As with claim 8, the nature of the storage medium set forth in the specification does not permit functionality to be realized, and thus the claim invention is non-functional descriptive material and non-statutory.

Claim 14-17: Depend on claim 13.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1: The last line of claim 1 refers to a respective data set being “the same” as a stored data set. It is not clear at this step what makes the two sets the same or what features are being compared to determine that the two sets are the same.

Claim 2: In claim 1, the first attribute is made part of a probability calculation, so claim 2 contradicts claim 1 by stating that the first attribute is “non-calculated”. Once an attribute is recited as being part of a calculation, it cannot simultaneously be recited as not being part of a calculation.

Claims 3-7: Depend on claim 1.

Claim 8: Same basis of rejection as claim 1.

Claim 9-10: Depend on claim 9.

Claim 11: Same basis of rejection as claim 2. Once an attribute is recited as being part of a calculation, it cannot simultaneously be recited as not being part of a calculation (“non-calculated”).

Claim 12: Depends on claim 11.

Claim 13: Same basis of rejection as claim 1.

Claim 14: Depends on claim 13.

Claims 15-17: Same basis of rejection as claims 2 and 11.

Although no prior art is applied with this action, no allowable subject matter is indicated due the presence of rejections under 35 USC 101.

This action is made non-final.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell  
Primary Examiner  
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